

In re Apnl. of Anza Hormigo et al.
Application No. 10/564,949
Response to Final Office Action of March 18, 2010

REMARKS

The following remarks are responsive to the March 18, 2010, Final Office Action.

At the time of the Office Action, claims 1, 3–12, and 14 were pending. The status of the claims is as follows:

Claims 1, 3–12, and 14 stand rejected under **35 U.S.C. § 112, second paragraph**, as being indefinite;

Claims 1, 3–12, and 14 stand rejected under **35 U.S.C. § 103(a)** as being obvious over **Ouzounidis** (U.S. Patent No. 7,130,918) in view of **Kirkpatrick** (U.S. Patent No. 7,373,144);

Claim 3 stands rejected under **35 U.S.C. § 103(a)** as being obvious over **Ouzounidis** in view of **Kirkpatrick** and **Ganor** (U.S. Patent Publication No. 2004/0219908); and

Claim 5 stands rejected under **35 U.S.C. § 103(a)** as being obvious over **Ouzounidis** in view of **Kirkpatrick** and **O’Neil** (U.S. Patent No. 7,127,232).

Claims 1, has been amended to address the 35 U.S.C. § 112 issues, and claim 14 has been added for consideration by the Examiner. Applicants present arguments for distinguishing the present claims from the art cited against them below. Furthermore, Applicants respectfully assert that the amended claim language does not raise any new issues requiring a further search and therefore, should be entered in the present round of prosecution.

Applicants’ use of reference characters below is for illustrative purposes only and should not be considered as limiting unless expressly indicated as such.

35 U.S.C. § 112, Second Paragraph, Indefiniteness of Claims 1, 3–12, and 14

1. Applicants have amended independent claims 1, 10, and 14 to clarify timing issues raised by the Examiner.

In the Office Action, on pp. 2–3, the Examiner rejected claims 1, 3–12, and 14 as being indefinite because, as the Examiner indicated:

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The claim language implies that the first step is activated based upon the result of the second step. However, this language is indefinite based upon how the first and second steps are defined in the claim, which clearly recites that the result of the second step requires, or is based upon, the first step as mentioned above. To generalize, step A can not be activated based upon the result of step B, which requires step A.

In response, Applicants have amended independent claims 1, 10, and 14 to clarify the timing issues. As presently amended, the first step is activated by determining for the time delay: a) a first value (T1) when the state is not present, and b) when the state is present, a second value (T2) and, if needed, without reaction from the mobile telecommunication network after expiration of T2, a third value (T3). Applicants respectfully contend that this language clarifies the timing issues raised by the Examiner in the Office Action, and respectfully request that the 35 U.S.C. § 112 rejection be withdrawn.

35 U.S.C. § 103(a) Obviousness of Claims 1, 3–12, and 14 over Ouzounidis in View of Kirkpatrick

2. Applicants have amended independent claims 1, 10, and 14 to clarify that the first step is activated by determining for time delay: a) when the state is not present, a first value (T1); and b) when the state is present, a second value (T2) and, if needed, without reaction from the mobile telecommunication network after expiration of T2, a third value (T3). The combination of Ouzounidis and Kirkpatrick fails to teach or suggest this limitation.

In the Office Action, on pp. 3–6, the Examiner rejected claim 1 as being obvious over Ouzounidis in view of Kirkpatrick, noting how each of the claim elements was being read on by the disclosure of Ouzounidis and Kirkpatrick.

As the Examiner indicated, on p. 5, Ouzounidis does not disclose the time delay that is a function of the present or not present state.

According to Kirkpatrick, the time delays T1 and T2 are **only** set when the terminal is **not accessible** and they are **never** set when the terminal is **present**.

In contrast, the presently amended claims are distinguished in that the time delay is determined as a first value T1 when the state is not present, as a second value T2 when the state is present, and as a third value T3 when the state is present but no message has been received before the expiration of T2. Such different values of time delay are determined as a

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function of the state of presence or non-presence of the terminal in a network in a relevant way. These determinations of the time delay cannot be found in the combination of Ouzounidis and Kirkpatrick.

The following potential advantages flow from this design. These different values allow performance of a compromise between the need to limit the network traffic, on the one hand, and the need to rapidly inform of a mobile subscriber leaving the present state, on the other hand (see Specification, page 18, lines 5–10).

Furthermore, this difference allows a controlling and limiting of message traffic in the network (see Specification, page 17, line 29 – page 18, line 18).

Moreover, this difference is relevant in this context in which a mobile device in a present state is expected to provide an acknowledgement quickly (see Specification, page 18, lines 5–10).

Neither Ouzounidis nor Kirkpatrick, alone or in combination, discloses such time delays fixed as a function of the current state of presence, and these documents do not allow such a compromise to be made. Kirkpatrick teaches only a way to decide that the state of non accessibility of a terminal in a network can be considered as indefinite offline.

For these reasons, the Applicants assert that the claim language clearly distinguishes over the prior art, and respectfully requests that the Examiner withdraw the 35 U.S.C. § 103 rejection from the present application.

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Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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Date: June 17, 2010

CH01/ 25556765.1